

### **REMARKS/ARGUMENTS**

Reconsideration of this application is requested. Claims 1-5 and 7-16 will remain pending in the application.

Applicants note with appreciation the allowance of claims 1-4 and 10-15 with the potential allowability of claim 16 provided the claim is clearly worded to express the invention defined in it.

This response proposes to amend claim 5 for purposes of clarity and to assist in understanding why this claim is directed to patentable subject matter.

It is proposed to amend claim 16 to respond to the examiner's comments regarding claim clarity in the Official Action.

#### **Response to 35 USC §112, Paragraph 2 Rejection**

In the current Action, the Examiner points out that "at a temperature that is higher than the temperature which is lower than a decomposition temperature" added to claim 16 by the previous Amendment is unclear, and applicants agree the Examiner is right in pointing it out so. It is also a correct observation that the expression "at a temperature that is higher than the temperature which is lower than the temperature which is lower than a decomposition temperature of the organic group contained therein by 150°C and that is less than the decomposition temperature of the organic group" used in the originally filed claim 16 is also hard to understand.

The simple explanation is this: When the decomposition temperature is A (measured in centigrade degrees), the above phrase in the originally filed claim 16 means "at a temperature between A(°C) and A-150(°C)". As an example then, if the decomposition temperature A is 500°C, the preliminary calcining temperature will be between 500°C and 350°C.

The preliminary calcining step is carried out at the above temperature, because if the preliminary calcining step is carried out at a temperature higher than the decomposition temperature, polyorganosiloxane particles are decomposed and it is hence meaningless to carry out the subsequent calcining step. As to the lower limit, when the above preliminary calcining step is carried out at a temperature lower than the decomposition temperature by 150°C or more, it is difficult to carry out the preliminary calcining.

While applicants appreciate the version of claim 16 proposed by the examiner it does not agree with applicants' objectives as to the lower limit, as explained above. The above version of claim 16 is believed to be clear and consistent with applicants' objectives (even though inartfully worded in original (claim 16).

Response to 35 USC §103(a) Rejection

In the Office Action, claims 5 and 7 to 9 are rejected as being "obvious" over the Ishikubo JP patent in view of the Okamoto JP patent.

Applicants now explain the patentability of claim 5, the independent claim. The method of claim 5 includes the step (A) of hydrolyzing and condensing a silicon compound (I) of the type specified to form seed particles of the polyorganosiloxane particles and the step (B) of mixing these seed particles with a particle-diameter-growing aqueous solution to grow the seed particles. Claim 5 has its characterized feature in step (B) in which specific procedures are carried out. That is, the diameters of the seed particles are measured, continuously or at intervals of a constant time period, in which part of the reaction solution is sampled and contacted with a protective-colloid-forming agent to form a protective colloid on the particles in the reaction solution. Then the particle diameters are measured using the Coulter method and the reaction is terminated when an intended particle diameter is reached.

The Ishikubo JP patent as a primary reference relates to the general requirements of step (A) and step (B), as recited in the appropriate two-thirds of claim 5, but fails to disclose the characteristic requirements of claim 5, described in the last third of claim 5, that is, the procedure for monitoring particle growth then terminating the reaction when the predetermined particle diameter is reached.

The above point is acknowledged in the outstanding Office Action, page 3, lines 13 to 15 and page 4, lines 1 to 5.

The Examiner appears to point out that the Okamoto JP patent as a secondary reference discloses the characterizing features of step (B) of claim 5. The passage of the Okamoto JP patent in paragraph [0028] pointed out by the Examiner merely discloses that in the step of forming seed particles (corresponding to the step (A) of claim 5), part of a seed particle-containing solution is sampled and the sampled solution is brought into contact with a protective

colloid-forming agent to form a protective colloid on each seed particle and then the seed particles are measured with a Coulter counter.

According to the Okamoto JP patent, in [0030] to [0034], the amount of a solution for growing particles in diameter is determined depending upon an intended final particle diameter, and in [0035], a solution for growing particles in diameter is added to a seed particles-containing solution, whereby intended polyorganosiloxane particles are obtained by the growth of the particles in diameter.

As explained above, the Okamoto JP patent merely discloses that it measures the seed particles for diameter only once, and it does not at all disclose or suggest any requirement that growing seed particles are measured for diameters continuously or at intervals of a constant period of time and monitored.

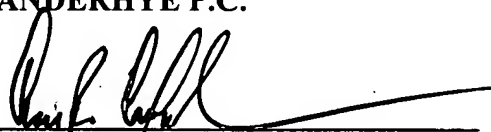
Therefore, claim 5 is not suggested by the Ishikubo JP patent in view of the Okamoto JP patent, and claim 5 is patentable. Claims 7 to 9 dependent upon claim 5 are hence patentable as well. *See* MPEP §2143.03

For the above reasons it is respectfully submitted that all pending claims are compliant with 35 USC §112, second paragraph, and directed to inventive subject matter and in particular claims 5, 7-9 and 16 are in condition for allowance as claims 1-5 and 7-15 have been allowed. Should the examiner have any questions or concerns, please contact the undersigned.

Respectfully submitted,

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